

## REMARKS

applicants acknowledge the telephone restriction requirement made April 12, 2005 and the election of Group I, claims 1-20 for continued prosecution in this application.

Claims 1-17 have been provisionally rejected under the judicially created doctrine of obviousness-double patent over claims 1-8 of co-pending, commonly owned U.S. Patent Application Serial No, 10/828,832. A terminal disclaimer and fee is enclosed herewith disclaiming the terminal portion of any patent issued hereon after expiration of said co-pending application. In the claims the amount of Ni is limited in its lowest amount to that amount shown in Example 2 (the invention) on page 6 of the specification in the paragraph before Table 1. Claim 1 is limited to the Ni alone on an alumina support. New Claim 32 is limited to the Ni with specific additional components.

Claim 17 which was only rejected for double patenting, which has been overcome by the terminal disclaimer submitted herewith has been placed in independent form and is now in condition for allowance.

The rejection of claims 1, 7 and 8 under 35 USC 103(a) over Simpson et al is respectfully traversed. The claims are closed and no longer recite a Group VIB metals as required by Simpson et al and there is no reason to omit any essential portion of Simpson et al's components.

The amended claims and new claim 32 are submitted to have overcome the 102 over Hockele et al. In addition the preamble of the claims has been recast to provide the environment of the invention claimed and set forth in the first sentence of the specification and discussed in the examples and description. The preamble to a claim is an integral part of the claim which is not ignored. In *In re Szajna, et al.*, 164 USPQ 635, 636, (CCPA 1970) it held

that the preamble was more than a mere statement of intended use where "it gives 'life and meaning' to recitations in the body of the claims ---." In *In re Wallis, et al.*, 151 USPQ 185, 190 (CCPA 1966) the court had held that the preamble could not be ignored in view of the entire specification which was directed solely to compositions for the particular use. *In re Duva*, 156 USPQ 90, 94,(CCPA 1967) (citing *Kropa v. Robie*, 88 USPQ 478 480-81(CCPA 1951) and *In re Walles, supra*) found, "thus, all *factual* differences which may be properly noted in any portion of a claim must be included within the basis for comparison with the prior art if we are to properly evaluate the *differences* between the invention defined in a claim and the teachings of a reference." Where the preamble established an "environment" as part of the claim, without which the relationship between the various elements of the invention set forth in the body of the claims would be meaningless, the preamble does not merely set forth a different use of prior art. *Ex parte Futo*, 59 USPQ2d 1955 (BdPatApp&Int 2000).

The rejection of claims under 35 USC 103(a) over either Best or Blanchard et al is respectfully traversed.

Best and Blanchard et al references are non analogous art and cannot make any aspect of the present invention obvious.

"Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is pertinent to the particular problem with which the inventor is involved." *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

The purpose of both the inventor and the reference are important in determining pertinence for the different endeavor reference. If the same purpose is disclosed in the reference that supports the use of the reference the art would likely be considered analogous.

"If it is directed to a different purpose, the inventor would accordingly have had less motivation

or occasion to consider it" *In re Clay, supra* at 1061.

Neither Best nor Blanchard et al are not reasonably pertinent to the particular problem with which the applicants were involved. An inventor is not presumed to have full knowledge of prior art outside of the field of his endeavor. *In re Antle*, 170 USPQ 285, 287 (CCPA 1971); *In re Wood*, 202 USPQ 171, 174 (CCPA 1979).

The issue of whether art is reasonably pertinent to the particular problem on which an inventor was involved is not soundly based on the Patent Office classification system. *In re Mlot-Fijalkowski*, 213 USPQ 713, Footnote 715 (CCPA 1982). Thus, there must be a reason or rationale (similar in logic to the requirement that there be a reason for use of a reference).

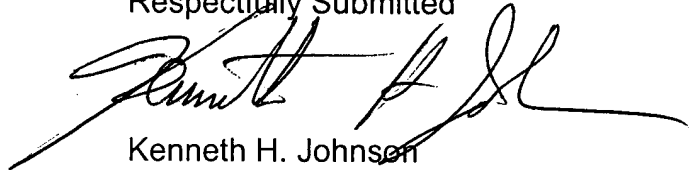
The examiner did not advance any reason as to why an amination catalyst (Best) or a catalyst for automotive exhaust (Blanchard et al ) are pertinent other than a hindsight need for a portion of the teachings. References must be treated as a whole, not just selected bits and pieces from prior patents which might then be modified to fit an incorrect interpretation of the claims. *In re Panduit Corp. v. Dennison Manufacturing Co.* 1 USPQ2d 1593, 1605 (CAFC 1987). "The inventor would have the ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains." *In re Antle, supra* 287. There is no broad area of subject matter which concerns the present invention and which would cause anyone to look to the art of amination or exhaust treatment for a teaching relevant to the present invention.

There is no common environment which could form a "close relationship" between either the claimed invention and the fields of research in these two references which would logically require their consideration. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981). The

problem which arises in viewing non analogous art as pertinent is that too narrow an area of the reference is focused on while the subject matter of the reference as a whole is not considered. *Pagliaro, supra* 893. "The Board has relied on isolated teachings of the prior art without considering the over-all context within which those teachings are present". *Pagliaro* citing *In re Mercier*, 515 F. 2d 1161, 1166, 185 USPQ 774, 778 (CCPA 1975). The examiner in *Pagliaro* found the non-analogous art (possibly and used the narrow teaching needed for a 103 from the non analogous art.

It is respectfully submitted that the present amended claims and new claim are neither anticipated nor made obvious by the art of record and as such that the claims are in condition for allowance.

Respectfully Submitted



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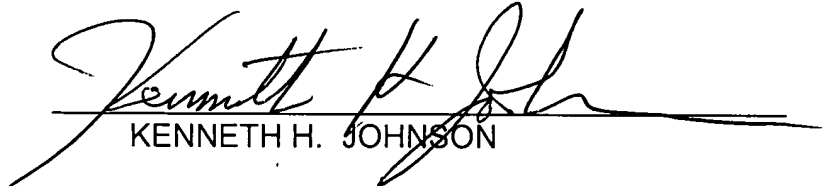


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